

REMARKS

Claims 1-20 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 103(a) Rejections:

The Office Action rejected claims 1, 2, 5, 7, 8, 12-15, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Harrell et al. (U.S. Publication 2002/0156656) (hereinafter “Harrell”) in view of www.pipinsure.com (<http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html>) (hereinafter “Pipinsure”) in further view of Keuper (DE 44 46 203) (hereinafter “Keuper”), claim 3 as being unpatentable over Harrell in view of Pipinsure and Keuper and further in view of Welles et al. (U.S. Patent 5,686,888) (hereinafter “Welles”), claims 4, 6, 9-11, 16 and 17 as being unpatentable over Harrell in view of Pipinsure and Keuper and further in view of Bennett et al. (U.S. Patent 7,117,170) (hereinafter “Bennett”), and claim 18 as being unpatentable over Harrell and Pipinsure and Keuper and further in view of Kepler (U.S. Patent 5,347,845) (hereinafter “Kepler”). Applicant respectfully traverses these rejections for at least the following reasons.

Claim 1

1. The cited art fails to teach or suggest i) generating a data file comprising at least the following: item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment, and ii) storing the data file in a memory device that accompanies the item during said shipment.

Keuper is the only reference that mentions anything at all about a memory device that accompanies an item during shipment. This memory device is described as storing

“filling data.” Filling data is data about contents of Keuper’s barrel (e.g., data about beer). This data does not include insurer information as claimed, nor do any of the cited references teach storing insurer information in a memory device that accompanies an item during shipment.

In the Advisory Action of February 22, 2010, the Examiner acknowledges that Keuper’s beer keg tag does not include insurance-related information (Advisory Action, page 3, line 11). The Examiner asserts:

[I]t would have been obvious to include the electronic insurance information as the process of transferring the data to the memory device on the item to be shipped would be the same, regardless of the information. (*Id.* at page 3)

Applicants note that, under the Examiner’s reasoning, it would allegedly be obvious to include any conceivable type of information within Keuper’s beer keg tag simply because “the process of transferring the data to the memory device on the item to be shipped would be the same.” Applicants respectfully disagree. The Examiner’s focus should not be the *manner* in which the cited teaches the transfer of data to a memory device. **Instead, the focus should be *what specific information is transferred to a memory device that accompanies an item during shipment according to the actual teachings of the cited art.*** In this case, neither Harrell, Pipinsure nor Keuper (considered singly or in combination) teach or suggest the generation of the specific type of data file of claim 1 (e.g., a data file including item information and insurer information that specifies an insurer selected to provide insurance), nor the process of storing that specific type of data file in a memory device that accompanies an insured item during shipment.

2. Furthermore, the cited art fails to teach or suggest accessing the memory device during or subsequent to said shipment from the origination to the final destination, and providing a notification to the insurer specified by the insurer information of said

data file stored in the memory device in regard to damage that occurred during said shipment.

Keuper teaches a keg tag that includes filling data. As described above, filling data as taught by the cited art does not include insurer information as claimed, nor do any of the cited references teach storing insurer information in a memory device that accompanies an item during shipment. More specifically, because the cited art fails to teach or suggest the specific data file stored in the memory device claimed, the cited references cannot teach providing a notification to the insurer specified by the insurer information *of said data file stored in the memory device* in regard to damage that occurred during said shipment. Indeed, neither Harrell, Pipinsure nor Keuper (considered singly or in combination) teach or suggest anything about this specific manner of providing a notification to an insurer.

3. Furthermore, the cited art fails to teach or suggest searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment. In the final Office Action, the Examiner cites pages 2, 8 and 9 of Pipinsure with respect to this limitation. Pipinsure discloses a series of questions a user can answer to “request a free quote on your package insurance needs.” The questions pertain to *general characteristics* of a user's shipping *habits* including *average* number of packages insured per day and *average* value per insured package. **The whole point of the Pipinsure reference is to provide a customer with a savings quote based on aggregate shipping characteristics. The Pipinsure reference, considered singly or in combination with the other cited references, does not actually teach or suggest selecting particular insurance for an item during shipment from an origination to a final destination.** Moreover, Pipinsure certainly does not teach *searching a database* to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment. The teachings of Harrell and Keuper fail to overcome the deficiencies of Pipinsure with respect to this claim

limitation. Neither Keuper's beer tag transponder system nor Harrell's method for obtaining marine cargo insurance teach or suggest any thing at all about searching a database to select particular insurance according to the specific limitations of claim 1.

In the Advisory Action of February 22, 2010, the Examiner cites pages 8 and 10 of Pipinsure (*Id.* at page 3). The "shipping needs, value of items to be shipped and coverage desired" cited by the Examiner are all *average or aggregate characteristics of a shippers general shipping habits*. This is corroborated by the fact that Pipinsure provides a *savings quote* based on a user's shipping aggregate shipping *habits*. In Pipinsure, the information requested from a user is not information for a *particular* insurance policy for shipping an item from an origination to a destination.

Furthermore, the actual evidence of record disclosed by Pipinsure is silent with respect to searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment. In the Advisory Action of February 22, 2010, the Examiner asserts "Pipinsure utilizes a broker for handling policy changes (page 23) suggesting the availability of different policies." Applicants note the existence of "different policies" neither teaches nor inherently includes "searching a database to select particular insurance for the item according to one or more insurance criteria." For example, a broker may manually perform policy changes absent the use of a database.

4. Applicant asserts the Examiner has failed to provide a proper reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of Keuper with the teaching of Harrell and Pipinsure. The Examiner asserts:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method comprising a memory device that accompanies an item during said shipment as taught by Keuper, within the method of Harrell and Pipinsure, with the

motivation of acquiring shipment handling data on an item. (Final Office Action of December 7, 2009; pages 3 – 4; emphasis added)

However, Harrell alone provides mechanisms for “acquiring shipment handling data on an item.” For instance, in paragraph [0043] of the Harrell reference, it is clear that Harrell’s system receives “mode of conveyance” information for a cargo shipment via a “quote creation process.” Since the “mode of conveyance” information for a cargo shipment clearly falls within the scope of “shipment handling data on an item” and since Harrell’s system includes a “quote creation process” to receive such information, Harrell’s system is already equipped to “acquir[e] shipment handling data on an item.” Accordingly, one seeking to “acquir[e] shipment handling data on an item” would simply use the teachings of Harrell alone, not combine the teachings of Harrell with the teachings of another reference, much less the teachings of Pipinsure and Keuper. The Examiner has merely provided a reason to use the teachings of Harrell alone, not a reason to combine the teachings of Harrell with Pipinsure and Keuper. **The Examiner does not directly address this specific argument in the Advisory Action.**

In the Advisory Action of February 22, 2010, the Examiner provides another alleged reason as to why the combination of the references would have been obvious to one of ordinary skill in the art. On page 4 of the Advisory Action, the Examiner asserts such a combination would have been obvious because “the claimed elements are merely a combination of old elements and in the combination, each element merely would have performed the same function as it did separately” and “the results of the combination were predictable.” **However, for arguments sake, if “each element merely []performed the same function as it did separately” (as asserted by the Examiner), the resultant combination would clearly not meet the specific limitations of claim 1 for at least the reasons presented above.** For instance, no portion of the cited art teaches generating the particular type of data file claimed, storing such data file in a memory device accompanying the insured item during shipment, and providing a notification to an insurer specified by the insurer information of the data file in regard to damage that occurred during shipment. For at least these reasons, if the Examiner is proposing a combination of the cited references in which “each element merely

[]perform[s] the same function as it did separately,” such a combination would clearly fail to meet the specific limitations of claim 1.

As the Examiner is certainly aware, “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (emphasis added). *KSR v. Teleflex*, 550 U.S. 398 (2007), 82 USPQ2d 1385, 1396. **Since the Examiner’s proposed reasoning fails to meet this standard, the Examiner’s rejection is improper.**

5. Furthermore, the Pipinsure reference has not been shown to be prior art to the present application. The Examiner has not properly established a publication date of the Pipinsure reference. The Examiner relies on the website <http://www.archive.org> for establishing that the Pipinsure reference was available as of 2000. However, there is no guarantee that the dates or even the content of what is supplied by <http://www.archive.org> is accurate. Applicant notes that the Terms of Use for <http://www.archive.org> (see <http://www.archive.org/about/terms.php>) state:

You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. We make no warranty of any kind, either express or implied.

Thus, since <http://www.archive.org> does not guarantee the accuracy of its collections, Applicant asserts that it is not proper to rely on <http://www.archive.org> to establish a publication date. Furthermore, even if the Pipinsure reference was published prior to Applicant's date of invention, there is no guarantee that the copy downloaded by the Examiner is an *accurate copy of what was published*. **This is especially true since <http://www.archive.org> specifically states that they do not guarantee the accuracy of their content.**

For the above reasons, Applicant asserts that there is insufficient evidence of record to establish that the Pipinsure reference downloaded by the Examiner qualifies as prior art. Also, as noted above, even if the Pipinsure reference is prior art, Pipinsure in view of the other cited references fails to teach or suggest the specific limitations of claim 1.

In the Advisory Action of February 22, 2010, the Examiner asserts “<http://www.archive.org> collects information from various web sites; the actual website is responsible for the accuracy of the content; <http://www.archive.org> merely provides a link to the Pipinsure website, it does not provide the content.” **The Examiner is incorrect.** The website <http://www.archive.org> operates by acquiring purported “snapshots” of web pages at different points in time. These snapshots are actually stored in <http://www.archive.org> databases. However, as demonstrated above, <http://www.archive.org> provides no guarantee as to the accuracy of such snapshots; therefore, it is improper for the Examiner to rely on the Pipinsure reference. Furthermore, the Examiner’s citation of MPEP 2128 is also rendered moot by the fact that <http://www.archive.org> does not guarantee the accuracy of its collections. Relying on <http://www.archive.org> for the date of availability would at least require <http://www.archive.org> to guarantee representations of historical web content (and the Pipinsure reference in particular) as being accurate.

Thus, for at least the reasons presented above, the rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested.

Claims 19 and 20

The rejection of claims 19 and 20 is not supported by the cited art for at least reasons presented above with respect to claim 1.

Furthermore, the Office Action failed to state a *prima facie* rejection of claims 19 and 20 because the Office Action failed to address specific limitations of 19 and 20. For

instance, claim 19 recites "search a database to select particular insurance for the item according to one or more insurance criteria, **wherein the particular insurance provides maximum insurance coverage for the item during said shipment for the least cost**" (claim 20 includes a similar limitation). The Office Action rejected claims 19 and 20 for under the rationale used to reject claims 1, 2 and 6 (see page 6 of December 7, 2009 Office Action). However, claims 1, 2, and 6 are **not** commensurate with the aforesaid claim limitation of claim 19. None of claims 1, 2 and 6 recite "search a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides *maximum* insurance coverage for the item during said shipment for the *least cost*." Accordingly, the Office Action failed to state a *prima facie* rejection of claims 19 and 20. Nor does the cited art teach or suggest the aforesaid limitation of Applicant's claim.

In the Advisory Action of February 22, 2010, the Examiner cites page 8 of the Pipinsure reference and asserts "Pipinsure provides a data field in which a user may input the highest insured value of any package when request a quote for package insurance." However, as demonstrated above, the user is not requesting a quote *for package insurance* in Pipinsure. Instead, the form fields of Pipinsure are fields for providing general shipping habits in order to obtain a *savings quote*.

Dependent Claims

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time. Applicants reserve the right to present additional arguments.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00901/RCK.

Respectfully submitted,

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